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4/12/07

In re Application of:

SPECTOR, AVNER

Serial No.: 10/617,037

Filed: Jul. 11, 2003

Docket: 26141

Title: PRESSURE-PULSE THERAPY
APPARATUS

DECISION ON PETITION OF
NON-ENTRY OF AFTER
FINAL AMENDMENT

This is a decision on the petition filed on Jan. 16, 2007 to enter the amendment after final under 37 CFR 1.116. The petition is being considered pursuant to 37 CFR 1.181.

The petition is **DISMISSED**.

In the petition the applicant requests a review of the examiner's refusal to enter the amendment after final filed on Dec. 11, 2006 in the Advisory Action issued by the examiner on Jan. 16, 2007. In the Advisory Action, the examiner refused to enter the amendment after final because the newly amended claim 27 raises new issues requiring further consideration and/or search. In particular, petitioner attempts to broaden claim 27 by deleting the limitation "within said enclosure and". Petitioner stated that the newly amended claim 27 was made to correct a clear and obvious error since it was intended to be a generic claim.

The record shows that:

- 1) On Sep. 1, 2005, the examiner issued a non-final Office action and acknowledged the applicant's election of the species depicted in figure 7.
- 2) On Nov. 3, 2005, the applicant filed a response to the non-final Office action, presented amendments to claims 1, 3-6, 8 and presented new claims 19- 26.
- 3) On Jan. 30, 2006, the examiner issued a final Office action and rejected claim 25 under 35 USC 112 1st. The examiner stated that the specification as originally filed failed to disclose the limitations set forth in claim 25 pertaining to the elected species in combination with "non-overlapping zones".
- 4) On May 30, 2006, the applicant submitted an RCE, canceled claims 1-26 and presented new claims 27-46.
- 5) On Aug. 3, 2006, the examiner issued a non-final Office action and rejected claims 27-46 under 35 USC 112 1st paragraph and 35 USC 112 2nd paragraph.

- 6) On Sep. 8, 2006, the applicant amended claims 27 and 29.
- 7) On Nov. 20, 2006, the examiner issued a final Office action. In the final Office action, the examiner objected to claims 27-46 because in claim 27, line 6, "said closed end" lacked proper antecedent basis and rejected claims 33, 34 and 36-43 under 35 USC 112 1st paragraph for failing to comply with the written description requirement.
- 9) On Dec. 11, 2006, the applicant filed an amendment after final under 37 CFR 1.116 with amendments to claim 27.
- 10) On Dec. 29, 2006, the examiner issued an advisory action refusing to enter the Dec. 11, 2006 amendment after final because the deletion of the limitation "within said enclosure and" raises new issues requiring further consideration and/or search.
- 11) On Jan. 16, 2007, the present petition to request entry of the amendment after final of Dec. 11, 2006 was filed. Petitioner argues that the amendment after final was made to correct a clear and obvious error since claim 27 was intended to be a generic claim.

Discussion and Analysis

Relevant portions of 37 CFR 1.116 Amendments and affidavits or other evidence after final action and prior to appeal, state: (a) An amendment after final action must comply with 37 CFR 1.114 or this section. (b) After a final rejection or other final action (37 CFR 1.113) in an application or in an ex parte reexamination filed under 37 CFR 1.510, or an action closing prosecution (37 CFR 1.949) in an inter partes reexamination filed under 37 CFR 1.913, but before or on the same date of filing an appeal (37 CFR 41.31 or 37 CFR 41.61 of this title): (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action; (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. Furthermore, entry of amendments after final rejection is not a matter of right (see 37 CFR 1.116).

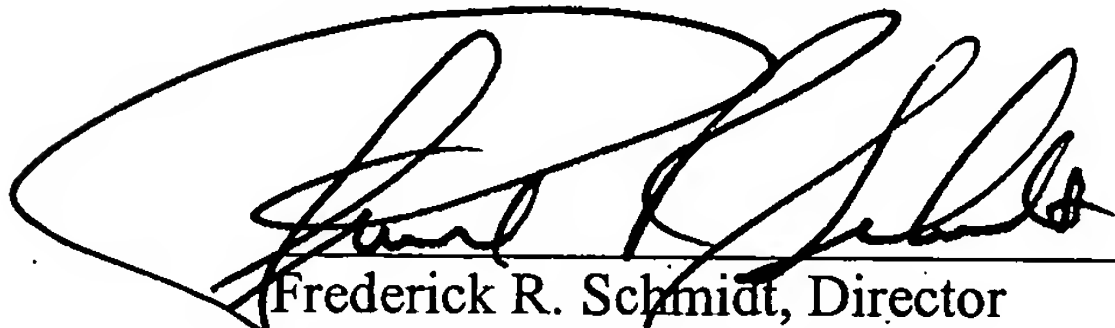
In order to determine whether or not that the broadened claim 27 raises new issues, which requires further consideration and/or search, a comparison of the newly amended claim 27 of Dec. 11, 2006 and the existing claim 27 of Sep. 8, 2006 under final rejection, must be made. The difference is the deletion of the limitation "within said enclosure and" from the finally rejected claim 27. The deletion of "within said enclosure and" broadened claim 27 which would require further consideration and search to the broader structure as correctly pointed out in the examiner's advisory action of Dec. 29, 2006. Applicant failed to show any good and sufficient reasons why the amendment is necessary and was not earlier presented. The review of the record shows that the examiner was in compliance with proper examining practice as set forth in MPEP 714.13. Therefore, the amendment after final filed on Dec. 11, 2006 is not in compliance with 37 CFR 1.116. The examiner's advisory action in refusing to admit the amendment of Dec. 11, 2006 is correct.

Conclusion

For the foregoing reasons, the relief requested by petitioners will not be granted. Specifically, the examiner's refusal admitting the amendment after final filed Dec. 11, 2006 is proper.

The application is being forwarded to Examiner Smith of Art Unit 3737 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is dismissed.



Frederick R. Schmidt, Director
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